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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------|-------------|----------------------|---------------------|------------------|
| 10/647,808 | 08/25/2003 | Michael C. Chang | 044319.001 | 2358 |
| 25461 | 7590 | 02/16/2005 | EXAMINER | |
| SMITH, GAMBRELL & RUSSELL, LLP | | | ARYANPOUR, MITRA | |
| SUITE 3100, PROMENADE II | | | ART UNIT | |
| 1230 PEACHTREE STREET, N.E. | | | PAPER NUMBER | |
| ATLANTA, GA 30309-3592 | | | 3711 | |

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,808

Applicant(s)

CHANG ET AL.

Examiner

Mitra Aryanpour

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 25 August 2003.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, an additional module as required in claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: on page 1, line 13, no clear meaning can be derived from “... have in the main been used ...”; on page 1, line 15, no clear meaning can be derived from “the propulsion by the player of the ball”. It appears applicant

Art Unit: 3711

may have intended to say “the propulsion of the ball by the player”; on page 5, line 9, the first occurrence of “that” should be deleted before “allow”; on page 7, line 5, “allows” should be singular; on page 7, line 6, --be-- should be inserted before “folded”. Appropriate correction is required for the above objections.

Claim Objections

3. Claim 14 is objected to because of the following informalities: no clear meaning can be derived from “the reflective surface and the second reflective surface”. Appropriate correction is required for the above objection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 12, 13, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Shieh (4,489,941).

Regarding claim 1, Shieh discloses a portable tennis backboard comprising: a first module (the lower frame work of web structure 2) comprising a base (the lower metal rim tubing 8) connected to a reflecting surface (webwork 3) having a height dimension, a width dimension, an anterior side and a posterior side (see figure 1); said reflecting surface being supported by at least one anterior gusset (the broadest reasonable interpretation of *anterior gusset* would include the front section of the footing racks 10) connected to the base; wherein the anterior gusset has a

Art Unit: 3711

major dimension that is less than or equal to half the height dimension of the reflecting surface (see figure 2).

Regarding claim 2, Shieh shows at least one posterior gusset (the broadest reasonable interpretation of *posterior gusset* would include the back section of the footing racks 10) attached to the posterior side of said reflecting surface.

Regarding claims 3-5, Shieh shows the anterior and posterior gussets have a tapered shape (best seen in figure 2).

Regarding claim 6, Shieh shows a stiffener (the broadest reasonable interpretation of *stiffener* would include the support rod or brace attached at one end to the footing racks 10 and at the other end at fastening bolts 12; it should be noted that the support rod has not been identified with a reference numeral) located on a posterior side of the reflecting surface (webwork 3).

Regarding claim 7, Shieh shows a stiffener (not identified with a reference numeral) located on a bottom posterior side of the reflecting surface (see figure 2).

Regarding claim 8, Shieh shows at least two posterior gussets (the back section of the footing racks 10) attached to the posterior side of said reflecting surface (positioned on either side of the webwork 3).

Regarding claim 9, Shieh shows an indicator on the surface of the reflecting surface (see column 3, lines 1-6).

Regarding claim 10, Shieh shows the anterior gusset (the front section of the footing racks 10) is shorter than said indicator's position on said reflecting surface (webwork 3).

Regarding claim 12, Shieh shows a second module (the upper frame work of web structure 2) comprised of a second reflective surface (webwork 3) and a second base (the upper metal rim tubing 8) connected to said first module (the lower frame work of web structure 2).

Regarding claim 13, Shieh shows the first module and second module (upper and lower web structure 2) are attached by a connecting part (joint fixture 13).

Regarding claim 15, Shieh shows the first module and second module can be attached by a supporting part (joint fixture 13).

Regarding claim 17, Shieh in the embodiment of figure 5 shows a portable tennis backboard comprising: a base (metal rim tubing 8); a reflective surface (webwork 3) attached to said base, a means for providing support to the reflective surface (left and right footing racks 10); and a means for creating a bottom-heavy weight distribution (the combination of the footing racks 10 and the support rods not identified with a reference numeral).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shieh (4,489,941).

Regarding claim 11, Shieh does not disclose expressly the inclusion of caster(s). At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to include caster(s), because Applicant has not disclosed that the

Art Unit: 3711

inclusion of caster(s), provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the base taught by Shieh or the claimed base with casters because both base perform the same function of providing support for the reflective surface. Therefore, it would have been an obvious matter of design choice to modify Shieh to obtain the invention as specified in claim 11.

Regarding claim 14, Shieh as disclosed above provides an indicator on the reflective surface. Shieh does not disclose providing separate indicators on both the top and bottom reflective surfaces. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have also included an indicator on Shieh's top reflective surface, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8 (7th Cir. 1977).

Regarding claim 16, Shieh as disclosed above does not show the inclusion of an additional module. It would have been obvious to one having ordinary skill in the art at the time the invention was made *to* include an additional module, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8 (7th Cir. 1977).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pfeilsticker; Millikan; Mantz; Steyn et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
14 February 2005



MITRA ARYANPOUR
PRIMARY EXAMINER